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Dkt. 40314-A/JPW/MVM

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Thomas M. Jessell et al.

Serial No : 10/002,278

Filed November 2, 2001

For : CLONING, EXPRESSION AND USES OF DORSALIN-1



1185 Avenue of the Americas  
New York, New York 10036  
March 22, 2002

Assistant Commissioner for Patents  
Washington, D.C. 20231

Sir:

INFORMATION DISCLOSURE STATEMENT

In accordance with their duty of disclosure under 37 C.F.R. §1.56, applicants direct the Examiner's attention to the following references which are listed on the PTO-1449 form attached hereto as **Exhibit A**. Copies of references 8 and 11 are attached hereto as **Exhibits 1** and **2**, respectively.

1. U.S. Patent No. 5,661,007 issued August 26, 1997 to Wozney et al.;
2. PCT International Publication No. WO 88/00205, published January 14, 1988 on behalf of Wang;
3. PCT International Application No. PCT/US92/05374, filed June 25, 1992, International Publication No. WO 93/00432A, published January 7, 1993 on behalf of Genetics Institute, Inc.;
4. PCT International Application No. PCT/US90/01630, filed March 27, 1990, International Publication No. WO 90/11366A, published October 4, 1990 on behalf of Genetics Institute, Inc.;
5. Basler et al. (1993) "Control Of Cell Pattern In The Neural

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Applicants: Thomas M. Jessell et al.  
Serial No.: 10/002,278  
Filed : November 2, 2001  
Page 2

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Tube: Regulation Of Cell Differentiation By Dorsalin-1, A Novel TGF- $\beta$  Family Member" Cell 73: 687-702;

6. Ferguson et al. (1992) "decapentaplegic Acts As A Morphogen To Organize Dorsal-Ventral Pattern In The Drosophila Embryo" Cell 71: 451-461;
7. Jakowlew et al. (1988) Molecular Endocrinology 2: 1186-1196;
8. Kingsley, D.M. (1994) "The TGF- $\beta$  Superfamily: New Members, New Receptors, And New Genetic Tests Of Function In Different Organisms" Genes & Development 8:133-146 (**Exhibit 1**);
9. Lyons et al. (1989) Proc. Natl. Acad. Sci. 86: 4554 and 4558;
10. Sambrook et al. (1989) Molecular Cloning (Cold Spring Harbor Lab. Press) 3: 162;
11. Song et al. (1995) "Bone Morphogenetic Protein-9 Binds To Liver Cells And Stimulates Proliferation" Endocrinology 136(10): 4293-4297 (abstract only) (**Exhibit 2**);
12. Wharton et al. (1991) "Drosophila 60A Gene, Another Transforming Growth Factor  $\beta$  Family Member, Is Closely Related To Human Bone Morphogenetic Proteins" Proc. Natl. Acad. Sci., U.S.A., 88: 9214-9218; and
13. Wozney et al. (1988) "Novel Regulators Of Bone Formation: Molecular Clones And Activities" Science 242: 1528-1534.

The subject application is a continuation of and claims the

Applicants: Thomas M. Jessell et al.  
Serial No.: 10/002,278  
Filed : November 2, 2001  
Page 3

benefit under 35 U.S.C. §120 of U.S. Serial No. 08/065,844, filed May 20, 1993.

The above listed reference 12 was submitted to and considered by the United States Patent and Trademark Office in an Information Disclosure Statement filed October 13, 1993 in connection with U.S. Serial No. 08/065,844, filed May 20, 1993. Above-listed references 6 and 10 were cited by the United States Patent and Trademark Office in an Office Action dated July 27, 1994 in connection with U.S. Serial No. 08/065,844, filed May 20, 1993. Above-listed references 2, 7 and 9 were cited by the United States Patent and Trademark Office in an Office Action dated June 27, 1996 in connection with U.S. Serial No. 08/065,844, filed May 20, 1993. Above-listed references 5, 6 and 13 were submitted to and considered by the United States Patent and Trademark Office in a Supplemental Information Disclosure Statement filed November 28, 1997 in connection with U.S. Serial No. 08/065,844, filed May 20, 1993. Above-listed reference 1 was cited by the United States Patent and Trademark Office in an Office Action dated February 17, 1998 in connection with U.S. Serial No. 08/065,844, filed May 20, 1993. Accordingly, under 37 C.F.R. §1.98(d) copies of these references are not required to be provided to the United States Patent and Trademark Office, since they were previously submitted to or cited by the United States Patent and Trademark Office in an application relied upon for an earlier filing date under 35 U.S.C. §120.

PCT International Application No. PCT/US94/05743, filed May 20, 1994, is a foreign counterpart application of the subject application. An International Search Report was issued on August 15, 1994 in connection with PCT International Application No. PCT/US94/05743. A copy of the Search Report is attached hereto as **Exhibit B**. Above listed references 5, 6, 12 and 13 were cited in the Search Report. References 5, 6 and 13 were submitted to

Applicants: Thomas M. Jessell et al.  
Serial No.: 10/002,278  
Filed : November 2, 2001  
Page 4

and considered by the United States Patent and Trademark Office in a Supplemental Information Disclosure Statement filed November 28, 1997 in connection with U.S. Serial No. 08/065,844, filed May 20, 1993. Reference 12 was submitted to and considered by the United States Patent and Trademark Office in an Information Disclosure Statement filed October 13, 1993 in connection with U.S. Serial No. 08/065,844, filed May 20, 1993. Accordingly, under 37 C.F.R. §1.98(d) copies of these references are not required to be provided to the United States Patent and Trademark Office, since they were previously submitted to the United States Patent and Trademark Office in an application relied upon for an earlier filing date under 35 U.S.C. §120.

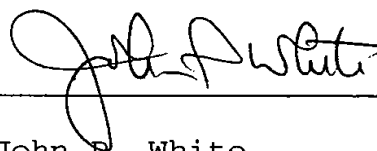
European Application No. EP 94 91 7463, is a foreign counterpart application of the subject application. A Supplementary European Search Report was issued on February 17, 1999 in connection with EP 94 91 7463. A copy of the Search Report is attached hereto as **Exhibit C**. Above listed references 3 and 4 were cited in the Search Report. References 3 and 4 were submitted to and considered by the United States Patent and Trademark Office in a Supplemental Information Disclosure Statement filed April 29, 1999 in connection with U.S. Serial No. 08/065,844, filed May 20, 1993. Accordingly, under 37 C.F.R. §1.98(d) copies of these references are not required to be provided to the United States Patent and Trademark Office, since they were previously submitted to the United States Patent and Trademark Office in an application relied upon for an earlier filing date under 35 U.S.C. §120.

If a telephone interview would be of assistance in advancing prosecution of the subject application, applicants' undersigned attorney invites the Examiner to telephone him at the number provided below.

Applicants: Thomas M. Jessell et al.  
Serial No.: 10/002,278  
Filed : November 2, 2001  
Page 5

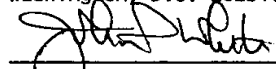
Pursuant to 37 C.F.R. §1.97(b)(3), no fee is deemed necessary in connection with the filing of this Information Disclosure Statement. However, if any fee is required, authorization is hereby given to charge the amount of any such fee to Deposit Account No. 03-3125.

Respectfully submitted,



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I hereby certify that this correspondence is being deposited this date with the U.S. Postal Service with sufficient postage as first class mail in an envelope addressed to: Assistant Commissioner for Patents Washington, D.C. 20231.

 3/22/02  
John P. White Date  
Reg. No. 28,678